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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,986	08/27/2001	Malcolm Roy	1210-CIP-01	5359

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EXAMINER
NELSON, FREDA ANN

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/939,986	ROY ET AL.
	Examiner	**Art Unit**	
	Freda A. Nelson	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-66* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-66* is/are rejected.

7)☒ Claim(s) *40* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This is in response to a communication filed March 12, 2004. Claims 1-66

are currently pending.

Claim Objections

1.   Claim 40 is objected to because of the following informalities:

Claim 40, line 2, "tracking" should be "track".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and
process of making and using it, in such full, clear, concise, and exact terms as to enable any
person skilled in the art to which it pertains, or with which it is most nearly connected, to make
and use the same and shall set forth the best mode contemplated by the inventor of carrying
out his invention.

2.   Claims 23-44 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the enablement requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention.

The examiner is unable to determine what the structural make-up of the

apparatus is. The applicant's claim language is directed towards a data source

which is not a device.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 38-40 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

4.   In claims 38-39, the examiner is unable to determine what the applicant

means by the claim language "a communicator programmed to communicate".

5.   In claim 40, the examiner is unable to determine what the applicant means

by the claim language, "a scheduler programmed to schedule".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

6.   Claims 23-44 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The applicant is claiming a

apparatus without its structural parts needed to realize the apparatus'

functionality.

7.   Claims 45-66 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The applicant is claiming a

computer program without the computer and/or machine and it's structural

interrelationship needed to realize the computer readable medium's functionality.

8.   Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; an,

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must-be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-22 only recite an abstract idea. The recited steps of establishing a hierarchical list of defined skills ... storing at least one said identified Intellectual Capital codes and said weighting factor in a data source does not apply, involve, use, or advance the technological arts (i.e. interaction in the steps with the computer/computer network or other equivalent means) since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an abstract idea.

Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the preamble "A computer implemented method for ---", or something similar and also includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have

a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat.

App. & Inter. 2001).

Although the recited process produces a useful, concrete, and tangible

result, since the claimed invention, as a whole, is not within the technological arts

as explained above, claims 1-22 are deemed to be directed to non-statutory

subject matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially
created doctrine grounded in public policy (a policy reflected in the statute) so as
to prevent the unjustified or improper timewise extension of the "right to exclude"
granted by a patent and to prevent possible harassment by multiple assignees.
See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re
Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644
(CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may
be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent is shown to
be commonly owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may
sign a terminal disclaimer. A terminal disclaimer signed by the assignee must
fully comply with 37 CFR 3.73(b).

9.   Claims 1-7, 9-21, 23-29, 31-51, and 53-65 are provisionally rejected under

are provisionally rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claims Claims 24-46 and 57-98

of copending Application No. 09/549,079 in view of Nadkarni (Patent Number

6,266,659).

The subject matter claimed in the instant application is fully disclosed in

the referenced copending application and would be covered by any patent

granted on that copending application since the referenced copending application

and the instant application are claiming common subject matter, as follows:

Both applications claim a method for cataloging skills comprising the steps

of: establishing a hierarchical list of defined skills;

assigning an alphanumeric symbol to each of said defined skills to create

an Intellectual Capital code for said defined skill;

receiving a set of submitted skills, wherein said set of submitted skills

contains at least one of said defined skills in said hierarchical list;

identifying said Intellectual capital cod corresponding to said defined skill

in said set of submitted skills;

adding at least one weighting factor to at least one of said Intellectual

Capital code in said set of submitted skills; and storing at least said identified

Intellectual capital codes and said weighting factor in a data source.

Furthermore, there is no apparent reason why applicant would be

prevented from presenting claims corresponding to those of the instant

application in the other copending application. See *In re Schneller*, 397

F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

10.   Claims 1-7, 9-21, 23-29, 31-51, and 53-65 are rejected under 35

U.S.C. 102(a) as being anticipated by Nadkarni (Patent Number 6,266,659).

In claims 1, 3, 12, 23, 25, 34, 45,47, and 56, Nadkarni discloses the
capturing of a candidate's skills or experiences in separate, specific fields (e.g.
"Profession", "Category", "Skill", "Specialty"), allows for very precise
categorization of skills and experience (col. 2, lines 53-56); Block 205 determines
whether or not the employer is satisfied with the results, i.e. whether he has
found too many or too few qualified candidates and if not, the process returns to
Block 203 where the search query is refined (col. 5, lines 53-56; Fig. 5(d)); and a
length-of-time field exists for each skill/category and allows for the summation of
time-per-skill across various stretches of employment (col. 2, lines 60-63); the
saving means allows the employer to store a number of different candidate
qualifications in libraries, which may be combined and modified to form various
search queries (col. 9, lines 32-35); and the skills/resume database system is
contained in the administration domain 111 and central to the system is a central
processing unit (CPU) 101 wherein the CPU 101 may be a single processor, or a
combination of processors, which may be configured in a PC, work station, main
frame or the like (col. 4, lines 40-45; FIG. 1); and the memory 104 contains a
program of instructional means for the system 100 to provide candidates,
vendors, and/or employers with "on-line" access to populate and search a
resume relational database (col. 5, lines 14-17).

In claims 2, 24, and 46, Nadkarni discloses that that the employer
formulates a query based on the requirements of the position opening (col. 5,
lines 42-44; FIGS. 2 and 5(a)-5(c)); next, the employer may specify the minimum
educational requirements of the position (col. 8, lines 12-14);

In claims 4, 26, and 48, Nadkarni discloses that the skills/resume
database system is contained in the administration domain 111 and central to the
system is a central processing unit (CPU) 101 wherein the CPU 101 may be a
single processor, or a combination of processors, which may be configured in a
PC, work station, main frame or the like (col. 4, lines 40-45; FIG. 1); and
structured as a relational database, it enables a user to input and/or search for
data with precision in a central hub for use by those seeking employment and
those seeking to hire (col. 4, lines 13-16).

In claims 5-6, 28, and 49-50, Nadkarni discloses that the system may also
have tabular and graphical means of making quantitative comparisons of the
selected candidates based on criteria selected by the employer (col. 4, lines 27-
30); comparing said selected client position to said prospect' (FIG 6(j)-6(n)); and
an employer may therefore specify a profession and a combination of
subcategories within that profession for a candidate, whereby using relational
database techniques and pattern matching algorithms, the combination can be
searched logically within the system's database (col. 9, lines 39-44).

In claims 7, 29, and 51, Nadkarni discloses that said weighting factor is
based upon "Last years Used" (FIG. 5(f)); and a length-of-time field exists for

each skill/category and allows for the summation of time-per-skill across various stretches of employment (col. 2, lines 60-63).

In claims 9, 31, and 53, Nadkarni discloses assigning a monetary value to at least one of said Intellectual Capital codes of at least one of said individuals; storing said monetary value in said data source; and computing a value for said selected individual based upon said monetary value (FIG 6(e)).

In claims 10-11, 15, 32-33, 37, 54-55, and 59, Nadkarni discloses that the system may provide the means for a candidate to update his information, e.g., his availability status, and/or retrieve information from the database via a telephone or other communicative link; and Block 303 is where the vendor enters details about the candidate's background   (col. 2, lines 38-41; FIG 3a).

In claims 13, 35, and 57, Nadkarni discloses that a personal or other computer equipped with a graphical interface terminal and a telecommunication link (modem, network connection, internet access, etc.), may be utilized to access the system (col. 4, lines 33-36; and operatively connected to the CPU is a database 102 wherein the database 102 can be any computer readable medium such as a hard drive, floppy disk, tape, CD ROM, RAM or other suitable medium (col. 4, lines 46-48).

In claims 14, 36, and 58, Nadkarni discloses that the formulation of the query search engine (domain 111, FIG. 1) is done by responding to prompts and/or pull-down menus from the system that correspond to the standardization, segmentation and organization of the relevant skills (col. 5, lines 44-47; FIG. 4)

In claims 16, 38, and 60, Nadkarni discloses that from a vendor's perspective, skilled manpower must be dedicated to matching various employers' job requirements with the backgrounds of available candidates and then submitting those candidates' resumes to the respective employers (col. 1, lines 60-65).

In claims 17, 39, and 61, Nadkarni discloses that in Block 305, the vendor enters details regarding the work one of its candidates is seeking (col. 6, lines 50-51; FIG. 6b); comparing said selected client position to said prospect' (FIG 6(j)-6(n)) .

In claims 18, 40, and 62, Nadkarni discloses scheduling and tracking said interview process between said prospect and said client (FIG. 6(i)); and indicia can be used to tag the candidate's resume for an employer's search and/or to file the resume immediately in the employer's mailbox, a mailbox corresponding to the position opening, or the like (col. 7, lines 15-18; FIG. 6(m)).

In claims 19, 41, and 63, Nadkarni discloses that if the employer is particularly interested in a candidate, the employer may schedule an interview on-line with the candidate in Block 207 (col. 6, lines 3-5; FIG. 5(h)).

In claims 20-21, 42-43, and 64-65, Nadkarni discloses scheduling and tracking said interview process between said prospect and said client (FIG. 6(i)); and indicia can be used to tag the candidate's resume for an employer's search and/or to file the resume immediately in the employer's mailbox, a mailbox corresponding to the position opening, or the like (col. 7, lines 15-18; FIG. 6(m)).

In claim 27, Nadkarni discloses that to provide access to the system for maintenance, control and monitoring, an administration interface 105 may be operatively connected to the CPU wherein the administration interface 105 is connected to an operator's interface 106, which may include a display and input means, and provides reports 107 (col. 4, lines 62-67); a data source interface communicating between said user interface and said data source, wherein said data source is capable of identifying said Intellectual Capital codes in said data source which correspond to each of said individual's skills storing said selected individual Intellectual Capital codes in said data source for said individual (FIG. 1); and the system may provide the means for a candidate to update his information, e.g., his availability status, and/or retrieve information from the database via a telephone or other communicative link; and Block 303 is where the vendor enters details about the candidates background   (col. 2, lines 38-41; FIG 3a).

In claim 40, Nadkarni discloses scheduling and tracking said interview process between said prospect and said client (FIG. 6(i)); and indicia can be used to tag the candidate's resume for an employer's search and/or to file the resume immediately in the employer's mailbox, a mailbox corresponding to the position opening, or the like (col. 7, lines 15-18; FIG. 6(m))

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 8, 30, 52 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Nadkarni (Patent Number 6,266,659).

In claims 8, 30, and 52, Nadkarni et al. does not explicitly disclose that said weighting factor includes a MUST, PLUS, or ANY identifier and said value in said comparison report is based upon said MUST, PLUS or ANY identifier. However, Nadkarni disloses that the system also uses complex logic to establish the relationships between various members of any subcategory, so that it automatically includes those candidates who have the skills that are functionally superior or inclusive of the ones specified by the employer in the search wherein such relational database search techniques are known in the art (col. 9, lines 39-44). Therefore, it is implied that a the system includes a MUST, PLUS, or ANY identifier to create well defined searches.

12.   Claims 22 and 66 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Nadkarni in view of Haq et al. (Patent Number

6,275,812).

In claim 22, Nadkarni not disclose that at least two of said submitted skills are skill bound to each other. Haq et al disclose that there is also a certain skill set (72) associated with each specialty that basically defines that specialty; and to perform each of the roles/responsibilities, a certain combination of skills would be required out of the comprehensive skill list for a specialty (col. 3, lines 28-32); and each specific role/responsibility (71) for a specialty must point (14)(15) to one or more skills (90)(93) in the skill set (72)(col. 3, lines 33-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Nadkarni to include the feature of Haq et al. to provide a more defined search.

Conclusion

13.   The examiner has cited prior art of interest, for example:

1) Clark et al. (Patent Number 5,164,897), which disclose an automated

method for selecting personnel matched to job criteria.

2) Durand et al. (Patent Number 6,272,467), which disclose a system for

data collection and matching compatible profiles.

3) Horowitz et al. (Patent Number 6,236,987), which disclose a dynamic content organization in information retrieval systems.

3) Sanders (Patent Number 6,411,936), which disclose an enterprise value enhancement system and method.

4) Sobotka et al. (Patent Number 5,197,004), which disclose a method and apparatus for automatic categorization of applicants from resumes.

5) Williams et al. (Patent Number 6,873,964), which disclose a method and system for recruiting personnel.

6) Tapsell, Sherrill, "Making money from brainpower: The new wealth of nations", July, 1998, Management-Aucklan, v45n6, PP: 36-43.

7) Greengard, Samuel, "Storing, Shaping and sharing collective wisdom", Oct 1998, Workforce, v77n10 PP: 82-88.
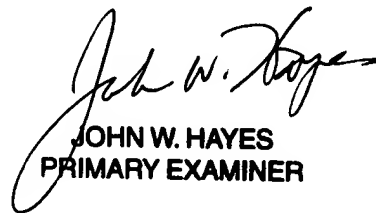

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 09/30/2005

JOHN W. HAYES
PRIMARY EXAMINER